

REMARKS

Claims 11-22, 24, 35-46 and 48 have been amended in accordance to the Examiner's comments.

Claims 11-22, 24, 35-46 and 48 are currently pending. No new matter is added by this amendment. The following addresses the rejections set forth in the April 11, 2008 Office Action.

Remarks regarding Attorney Docket Number

Please note the Attorney Docket Number for the above-identified case has changed from A800.081 to 0003.04.

Remarks regarding Claim of Priority

Applicant has made claim to foreign priority based on German application number filed on November 8, 2002. Pursuant to 35 U.S.C. §119(b), enclosed herewith is a certified copy of DE 10251918.8.

Rejection of Claims 11-22, 24, 35-46 and 48 Under 35 U.S.C. §112, first paragraph,

Enablement

The Examiner rejected claims 11-22, 24, 35-46 and 48 under 35 U.S.C. §112, first paragraph, stating that for not enabling or providing a written description regarding the structure of a second DNA cassette in general. Specifically, the Office Action contends that Applicant's disclosure does not sufficiently describe the second donor vector features of amended claims 11-22, 24, 35-48 and 48. This contention is respectfully traversed.

When a disclosure describes a claimed invention in a manner that permits one skilled in the art to reasonably conclude that the inventor possessed the claimed invention the written description requirement is satisfied. (MPEP §2163 (emphasis added)). This possession may be shown in any number of ways and an Applicant need not describe every claim feature exactly

because there is no in haec verba requirement. (MPEP § 2163). Rather, to satisfy the written description requirement, all that is required is “reasonable clarity.” (MPEP § 2163.02). Also, an adequate description may be made in any way through express, implicit, or even inherent disclosures in the application, including words, structures, figures, diagrams, and/or formulae. (MPEP §§ 2163(I), 2163.02).

As the amended, independent claims 11 and 35 now recite a second DNA cassette having heterospecific site-specific recombinase target sites and internal transposon half side. Applicant submits that one of ordinary skill in the art would reasonably conclude that Applicant’s disclosure adequately described the claimed invention at the time of filing at least inasmuch:

- (1) the structure of the second cassette is depicted in Figure 5 by the present application as it was originally filed,
- (2) the structure of the second cassette is depicted in Figure 7 by the present application as it was originally filed; and
- (3) Applicant describes the donor cassette on paragraph [00067] of the specification. Those of ordinary skill in the art would understand that such a disclosure expressly describes through the figures and description of a donor vector having heterospecific site-specific recombinase target sites and internal transposon half side, wherein said target sites flank additional DNA sequence. Thus, the present application adequately describes the claimed invention. Applicant thus respectfully requests favorable reconsideration and withdrawal of the rejection under 35 U.S.C. § 112.

In the event that the Office maintains this rejection, Applicant respectfully requests, in the interest of its policy of compact prosecution, that the Office explain how the aforementioned

portions of the present application fail to communicate to a skilled artisan that Applicant possessed the claimed invention.

Rejection of Claims 11-22, 24, 35-46 and 48 Under 35 U.S.C. §112, second paragraph

The Examiner rejected claims 11-22, 24, 35-46 and 48 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Those claims have been amended to more clearly define the invention and obviates the §112 rejection.

Specifically claims 11 and 35 have been amended to clarify additional DNA sequence.

Claims 14 and 38 have been amended to provide antecedent basis to recombinase target site.

Claims 19 and 43 have been amended to be dependent on claim 15 and claim 39 respectively, which provides antecedent basis to homing sequence.

Claims 21 and 45 have been amended to provide antecedent basis for the operable promoter.

The Applicant respectfully requests the rejection under 35 U.S.C. §112, second paragraph be withdrawn.

In view of the foregoing, it is respectfully submitted that pending claims 11-22, 24, 35-46 and 48 define allowable subject matter. Should anything remain in order to place the present application in condition for allowance, the Examiner is kindly invited to contact the undersigned at the telephone number listed below.

Amendment to Serial No. 10/534,226

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Respectfully submitted,



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